

REMARKS

Original Claims 1 to 5 have been cancelled. New Claims 6 to 20 have been inserted. The Abstract has been rewritten. Page 2, line 21 to 25, has been amended.

Support for new Claims 9 to 20 is found on page 3, line 26, to page 4, line 7 and page 1, lines 16 to 20 and 23 to 25, of the specification and in the Abstract, lines 22 to 25.

The Office Action stated that the state of the claims is:

Claims 1 to 5 are pending.

Claims 1 to 3 are allowed.

Claims 4 and 5 are rejected.

Claims 4 and 5 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants traverse this rejection.

The Office Action stated that the claims involving insufficient enablement and requiring undue experimentation to satisfy the first paragraph of 35 U.S.C. 112 finds support in case law. Applicants traverse this statement, as applied to applicants' claims and specification. The disclosures in this application, the knowledge and skill of one skilled in the art, and the published prior art clearly establishes that applicants' claims are supported by sufficient enablement for one skilled in the art to make and use the claimed invention and do not involve undue experimentation. The burden of proof is upon the Examiner to factually establish in the record the correctness of his assertion. The record is silent on the facts upon which he relies for his position. The Examiner has not carried his burden of proof.

The C.A.F.C. in Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, (1986), stated:

“ [a] patent need not teach, and preferably omits, what is well known in the art.” [Page 94]

Also, in U.S. v. Telectronics Inc., 8USPQ2d 1217, (1998), the C.A.F.C. stated:

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation” [Page 1222]

The types and components of lacquers, varnishes and solder resists and fibers used in fiber-reinforced composites are well known in the art and the prior art. This information is, in essence, therefore part of the disclosure of this application and forms part of the enablement of original Claims 4 and 5 and new Claims 9 to 20. There are numerous English-language books, articles and other literature on fiber-reinforced composites, lacquers, varnishes and solder resists in U.S. scientific and engineering libraries that readily provide such information.

European Published Patent Application No. 0315089 A2, that is in English and of record, discloses a number of reinforcing fibers used in fiber-reinforced composites.

The prior art available to one skilled in the art under Section 112, first paragraph, to show enablement includes U.S. patents, such as U.S. Patent Nos. 4,713,442 and 4,751,323, both of which are of record and which issued years before even the earliest foreign priority date of this application. In re Budnick, 190 USPQ 422, (C.C.P.A. 1976), states:

“Patents offered to prove the state of the art for the purpose of the enablement..., must have an *issue* date earlier than the effective filing date of the application on appeal.” [Page 424]

U.S. Patent No. 4,713,442 discloses, in its prior art section, a general scheme of polymerizing difunctional or polyfunctional aromatic cyanates into high molecular weight polytriazines. (Such patent further discloses its specific polymerization scheme.) Applicants use the approach of radiation-curing to polymerize their radiation-curable unsaturated oligophenol cyanates into polytriazine resins. Applicants' disclosure, the well known knowledge in the prior

art and the knowledge of one skilled in the art establishes that the specification provides enablement without the need for undue experimentation.

The claims do not require undue experimentation to satisfy Section 112, first paragraph, and the Examiner has not factually shown otherwise in the record.

The starting material for the "use" claims is sufficiently disclosed, described and enabled, as evidenced by the Examiner's statement in the Office Action that compound Claims 1 to 3 (which cover the starting material in the "use" claims) are allowed.

The Office Action stated compare In re Armbruster, 185 USPQ 152 (CCPA 1975) and In re Angstadt and Greiffin, 190 USPQ 214 (CCPA 1976).

As the C.C.P.A. said in the Angstadt et al. decision, the Examiner has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling, including why undue experimentation would be required. [Pages 7 and 8]

Claims 4 and 5 have been rejected under 35 U.S.C. 112, second paragraph.

The Office Action stated: that claims 4 and 5 provide for the use of the unsaturated oligophenol cyanates, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicants are intending to encompass; and that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually prepared. New process Claims 9, 11, 12, 14, 15, 18 and 19 recite active, positive process steps.

This rejection should be withdrawn.

Claims 4 and 5 have been rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.

The Office Action stated: that Claim 4 recites the limitation "matrix material for fibre-reinforced composites" and Claim 5 recites the limitation "radiation-

curable varnishes, resists, lacquers and coatings"; and that there is insufficient antecedent basis for these limitations in the claims.

These terms have sufficient "antecedent basis" and recited process steps, as appropriate, in the new claims.

This rejection should be withdrawn.

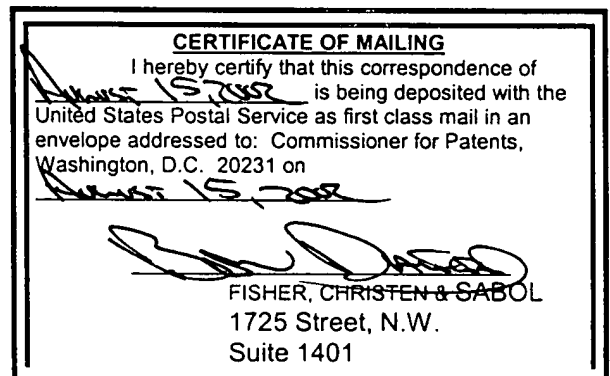
Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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Date

Virgil H. Marsh
Virgil H. Marsh
Reg. No. 23,083

Fisher, Christen & Sabol
Suite 1401
1725 K Street, N.W.
Washington, D.C. 20006
Tel: 202 659-2000
Fax: 202 659-2015





VERSION WITH MARKINGS TO SHOW CHANGES MADE

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In The Claims:

Original Claims 1 to 5 have been cancelled.

New Claims 6 to 20 have been inserted.

In The Specification:

The original paragraph on page 2, lines 21 to 25, has been replaced with the following rewritten version of the paragraph on page 2, lines 21 to 25, as amended:

In accordance with the invention this object is achieved by the unsaturated oligophenol cyanates of the formula I in accordance with [Claim 1] the invention. The molecule of these compounds has at least one olefinic double bond (R^4-R^4' and/or R^5-R^5' according to formula I) which permits free-radical addition polymerization.

In The Abstract

The original abstract has been replaced with the new abstract submitted on the separate page attached hereto.